

Appl. No. 10/629,990
Response to Final Office Action
Dated November 15, 2004

REMARKS

Applicants acknowledge receipt of the Final Office Action dated November 15, 2004. Claims 12-19 and 22-36 are pending in the application. The Examiner has allowed claims 12-19 and 25-36. The Examiner has objected to claim 24. In addition, the Examiner has rejected claims 22 and 23 under 35 U.S.C. § 102 as being anticipated by Hebert et al., U.S. Patent No. 5,878,818 ("Hebert"). Applicants believe that all pending claims are allowable over the art of record and respectfully request reconsideration and withdrawal of all rejections.

I. **Claims 22 and 23 are not anticipated by Hebert.**

Applicants respectfully traverse the Examiner's rejection of claims 22 and 23 under 35 U.S.C. § 102 as being anticipated by *Hebert*. Applicants submit that the claims are not anticipated by *Hebert* because *Hebert* fails to disclose each and every limitation of these claims.

Claim 22 is an independent claim upon which claim 23 is dependent. Claim 22 recites "setting the reference member within the cased borehole; then setting the anchor member in the cased borehole." Nothing in *Hebert* teaches or suggests setting a reference member and then setting an anchor member. The Examiner found that "[t]he reference member is met by the whipstock" of *Hebert*. (Final Office Action, pg. 2). Applicants submit that instead of teaching setting the whipstock in a wellbore, *Hebert* teaches placing the whipstock in a wellbore. Applicants note the Examiner's remarks "that the language 'setting' has several meanings." (Final Office Action, pgs. 2-3). However, Applicants respectfully submit that "setting" as taught in *Hebert* includes more than placement in the borehole but also includes engagement with the borehole. For instance, *Hebert* teaches a sidetracking assembly having a starter mill, whipstock

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and an anchor. (*Hebert*, col. 4, lns. 22-25). The lower end of the whipstock is threadably engaged with the upper end of the anchor. (*Hebert*, col. 5, lns. 11-13; Fig. 1B). When the sidetracking assembly with the whipstock and anchor are lowered into a borehole and reach a desired depth, *Hebert* teaches that slips in the anchor member are actuated and forced "into engagement with the steel pipe casing 7 thereby anchoring the mechanical set anchor in place within the cased wellbore." (*Hebert*, col. 4, lns. 27-30; col. 5, lns. 61-65, emphasis added). *Hebert* does not teach or disclose that the whipstock is "engaged" with the steel pipe casing, as *Hebert* teaches for his anchor. Instead, the whipstock of *Hebert* is taught to be lowered into the borehole and used to further set the anchor and not set itself. (*Hebert*, col. 5, ln. 66-col. 6, ln. 6). Please note that the specification of the present application teaches "setting" the reference member by engagement. For instance, the specification of the present application teaches that slips on "reference member 10 grippingly engage the wall of the casing 204 to permanently set reference member 10 within borehole 202." (Present Application, pg. 29, lns. 13-15). Nowhere does *Hebert* teach or disclose the whipstock engaging the casing and therefore does not teach or disclose "setting the reference member."

Applicants respectfully point out that *Hebert* does not teach setting the whipstock and then setting the anchor member. In view of the recitations in claim 22 that are neither taught nor suggested by *Hebert*, the Applicants respectfully request that the Examiner withdraw the § 102 rejection and allow claim 22. Applicants further request that the Examiner also withdraw the § 102 rejection of dependent claim 23, since it is submitted that independent claim 22 is allowable.

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Dependent claim 23 must *a fortiori* also be allowable, since it carries all the limitations of the independent claim to which it ultimately refers.

II. Claim 24 is allowable.

The Examiner has objected to claim 24 as "being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Final Office Action, pg. 3). Applicants respectfully submit that claim 24 is allowable as independent claim 22 to which it depends is also submitted to be allowable. Therefore, Applicants respectfully request the Examiner to withdraw the objection to claim 24.

III. Conclusion

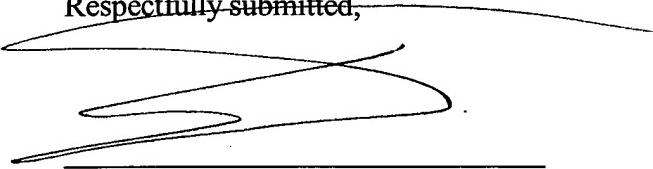
Applicants respectfully request reconsideration, allowance of the pending claims and a timely Notice of Allowance be issued in this case. The Examiner is respectfully requested to contact the undersigned if the Examiner feels that a telephone conference would expedite the resolution of this case.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art that have yet to be raised, but which may be raised in the future.

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If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769.

Respectfully submitted,


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